

REMARKSI. The 35 U.S.C. §103 Rejections

Claims 1-4, 10-11, 13, 15-16, 19-20, 23, 26, 29 and 30-33 were rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over King et al., U.S. Patent No. 5,895,471 (“KING”) in view of Lagarde et al., U.S. Patent No. 5,721,908 (“LAGARDE”). Applicant respectfully traverses the rejections.

In order to substantiate a prima facie case of obviousness, the initial burden rests with the Examiner who must fulfill three requirements. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. MPEP §2143.

A. Claim 1

Claim 1 recites a system for providing Internet-related services in response to a handheld device without requiring the handheld device to itself be Internet-enabled, comprising:

- a client module embedded in the handheld device to enable the handheld device to directly send a selected stored Universal Resource Locator (URL) via a local communication link, wherein the URL indicates a desired Internet web page;

- a receiver that receives the URL sent from the handheld device via the local communication link;

- a web access module coupled to the receiver and to an external Internet via an Internet communication link different from said local communication link to access and retrieve the desired web page from a remote web server via the external Internet; and

a render system being coupled to the web access module and physically separate from said handheld device, to render the retrieved web page in a human discernible format to a user on said render system.

The Examiner agreed that KING does not teach at least the claimed render system. Examiner relied on LAGARDE for allegedly disclosing the render system as recited in claim 1. Based on the arguments below, Applicant respectfully submits that LAGARDE is non-analogous art and should not have been combined with KING. In addition, there is no motivation to combine KING and LAGARDE. Instead, the Examiner applied impermissible hindsight reconstruction when combining the same. Lastly, even if the combination is proper, the cited references do not disclose or suggest every limitation of claim 1.

1. LAGARDE Is Non-Analogous Art

“In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” MPEP 2141.01 (a).

a. LAGARDE Is Not in the Same Field of Endeavor as Claim 1

Claim 1 recites a system for providing Internet-related services in response to a handheld device without requiring the handheld device to itself be Internet-enabled. Specifically, claim 1 addresses issues relating to, and usage of, handheld devices.

LAGARDE does not disclose or suggest any handheld devices or any solutions relating to handheld devices. Instead, LAGARDE discloses technology relating generally to data access from different sources over different networks. LAGARDE, col. 4, lines 61-66. The fact that accessed data may be displayed on different types of output devices does not make LAGARDE analogous to claim 1.

Technology relating to general data retrieval and access over different networks is not in the same field of endeavor as technology relating to the usage of handheld devices.

b. LAGARDE Is Not Reasonably Pertinent to the Particular Problem with which the Inventor Was Concerned

Claim 1 recites a system for providing Internet-related services in response to a handheld device without requiring the handheld device to itself be Internet-enabled. One of the problems being addressed by claim 1 relates to using a handheld device (which may or may not be Internet-enabled) to accessed specific requested web pages over the Internet. LAGARDE does not address any problems relating to handheld devices. In contrast, LAGARDE addresses the problem relating to accessing data located in multiple databases.

The problems with creating access to the world via the Internet and still to allow internal access to databases has been enormous. However, the need for a system which can be used across machines and operating systems and differing gateways is strongly felt by users of the Internet today. Anyone who has spent hours at a WWW browser doing simple task knows how difficult it still is to navigate thorough arcane rules without knowing where to go and even if you know what you are doing spending hours doing routine tasks. Many needs exist. As one important instance, until now we know of no way to access data on multiple databases of different types using a single user request from a client. This and other difficulties are solved by our invention. LAGARDE, col. 4, lines 21-34 (emphasis added).

Based on the foregoing, LAGARDE is non-analogous art and should not have been cited in combination with KING to reject claim 1.

2. There Is No Motivation to Combine KING and LAGARDE

“The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggest the desirability of the combination.” MPEP 2143.01. The Examiner has failed to point out any specific portion in the cited references (i.e., KING and LAGARDE) that suggests the

desirability of combining the teachings of KING and LAGARDE. The mere fact that LAGARDE discloses outputting data onto different types of output devices does not make the cited references combinable.

Thus, Applicant respectfully submits that the Examiner has failed to show that there is any motivation to combine the cited references. If the Examiner believes that these references do suggest the desirability of the combination, the Examiner is requested to cite the specific portions in the references in the next office action. If the Examiner is relying on personal knowledge for finding a motivation to combine, the Examiner is requested to provide an Affidavit so stating in accordance with 37 CFR 1.104(d)(2) and MPEP 2144.03.

3. Impermissible Hindsight Reconstruction

Improper hindsight reasoning should not be applied in support of an obviousness rejection. MPEP 2145.X.A. “It is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.” *Interconnect Planning Corp. v. Feif*, 774 F.2d 1132,1141, 227 USPQ 543, 550 (Fed. Cir. 1985); *W.L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 1553,220 USPQ 303,312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) (“To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record conveyor suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher”).

The Examiner has failed to point out where in either KING or LAGARDE the suggestion or teaching of the claimed invention may be found. The Examiner relied instead on the conclusory statement that it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of KING and LARGARDE. LAGARDE does not disclose or suggest any technology relating to handheld devices. Thus, Applicant respectfully submits that the Examiner applied improper hindsight reconstruction based on the Applicant’s Specification in support of the obviousness rejection. If the Examiner believes otherwise, the Examiner is requested to provide an Affidavit so stating in accordance with 37 CFR 1.104(d)(2) and MPEP 2144.03.

4. The Combination of KING and LAGARDE Does Not Disclose or Suggest Multiple Steps Recited in Claim 1

Even if the Examiner's suggested combination is proper, the combination fails to disclose or suggest at least one element in Claim 1. The Examiner relied on KING for allegedly disclosing all elements of claim 1 except for the render system.

However, KING fails to disclose or suggest at least the client module as recited in claim 1.

In claim 1, the client module embedded in the handheld device enables the handheld device to directly send a selected stored Universal Resource Locator (URL) via a local communication link, wherein the URL indicates a desired Internet web page.

In KING, the remote device builds a HDTP "Service Request" which includes a URL of a requested "deck" and sends the message to the computer. KING, col. 7, lines 26-29. The "deck" is a HDTP specific formatted unit of information which can be uniquely identified by a URL. KING, col. 5, lines 25-27. The URL of the deck does not indicate a desired Internet web page. Instead, the computer receiving the HDTP Service Request translates the Request into the URL of the desired web page to conform with HTTP requirements for fetching the desired web page. KING, col. 7, lines 38-40.

Therefore, the remote device disclosed in KING does not directly send a selected stored URL wherein the URL indicates a desired Internet web page as recited in claim 1.

Based on all the foregoing, Applicant respectfully submits that the combination of KING and LAGARDE is improper. Further, even if the combination is proper, the cited references fail to disclose or suggest all the limitations of claim 1. Therefore, claim 1 is not unpatentable over these references and should be in condition for allowance.

B. Claims 2-12 & 19-28

Claims 2-12 & 19-28 are dependent upon independent claim 1. Based on the foregoing with respect to independent claim 1, these dependent claims should also be in condition for allowance.

C. Claim 13

Independent claim 13 recites a render module physically separate from the handheld device. Based on the foregoing arguments for claim 1, claim 13 should also be in condition for allowance.

D. Claims 14-18

Claims 14-18 are dependent upon independent claim 13. Based on the foregoing arguments with respect to independent claim 13, these dependent claims should also be in condition for allowance.

E. Claim 29

Independent claim 29 recites a render module physically separate from the mobile system. Based on the foregoing arguments for claim 1, claim 29 should also be in condition for allowance.

F. Claims 30-31

Claims 30-31 are dependent upon independent claim 29. Based on the foregoing arguments with respect to independent claim 29, these dependent claims should also be in condition for allowance.

G. Claim 32

Independent claim 32 recites a render module physically separate from the mobile system. Based on the foregoing arguments for claim 1, claim 32 should also be in condition for allowance.

H. Claims 33-34

Claims 33-34 are dependent upon independent claim 32. Based on the foregoing arguments with respect to independent claim 32, these dependent claims should also be in condition for allowance.

II. Conclusion

Should the Examiner believe that a telephone interview would help advance the prosecution of this case, the Examiner is requested to contact the undersigned attorney.

Respectfully submitted,

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